

REMARKS

Claims 1-4 remain pending in the above-identified application with claims 1-2 standing rejected and claims 3-4 being withdrawn from consideration due to an earlier Restriction Requirement of the Examiner.

Claim Rejection Under 35 USC § 102(b)

Claims 1-2 have been rejected under the provisions of 35 USC § 102(b) as being anticipated by Yamada et al. US '553 (US 4,491,553). Reconsideration and withdraw of this rejection is respectfully requested based on the following considerations.

Legal Standard for Determining Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Distinctions Over Yamada et al. US 4,491,553

The Examiner argues, "(1) It is not clear why in the declaration, the aluminum hydroxide and resin emulsion are first dried and then added to SBR. (2) It is not clear what, if any, effect drying the aluminum hydroxide/PTFE emulsion mixture would have on the Y/X value of the produced resin

composition. (3) It is not clear what effect the differences in the method utilized in the present specification and the method utilized in the declaration would have on the Y/X index of the produced resin composite.” (See, page 6, lines 7-12 of the outstanding Office Action).

Regarding (1) and (2) as noted above, Yamada et al. teach that it is necessary to decrease the moisture content of the materials as far as possible in order to obtain shaped articles (resin composites) of good quality. See, column 6, lines 36-40.

In the experiment in the declaration filed April 5, 2005, a moisture content of aluminum hydroxide/PTFE emulsion mixture, which was used as materials, based on total weight of the resin composite is 3% $[(4.2 \text{ g PTFE emulsion} \times 40 \text{ wt\%, content of water}) / (6 \text{ g aluminum hydroxide} + 4.2 \text{ g PTFE emulsion} + 41 \text{ g SBR} + 0.6 \text{ g zinc oxide} + 0.6 \text{ g stearic acid} + 0.45 \text{ g age register} + 0.45 \text{ g wax} + 0.3 \text{ g vulcanization accelerator} + 0.3 \text{ g vulcanization accelerator} + 0.42 \text{ g sulfur})]$.

The moisture (3%) of aluminum hydroxide/PTFE emulsion mixture is much higher than the moisture (0.2%) of the resin blends obtained in Example 3 of Yamada et al.

As mentioned above, Yamada et al. teach that the aluminum hydroxide/PTFE emulsion mixture are preferably dried before being added to SBR.

According to the teachings of Yamada et al., the drying step is included in the production method used in the declaration filed April 5, 2005.

Regarding (3) as noted above, the method utilized in the present specification comprises steps of mixing an aqueous resin emulsion containing a resin with aluminum hydroxide having an average primary-particle diameter of 100 nm or smaller, letting the resin and the aluminum

hydroxide therein aggregate to obtain a slurry containing a resin composite and separating the composite from the slurry. (See withdrawn claim 3.)

Further, the aggregation is performed, for example, by changing pH of the mixture or by dropping the mixture into a saturated solution of an inorganic salt as described at page 10, lines 21-24 in the present specification.

The Examiner previously argues that “the particulate resin and the filler (AlOH) are mixed in the presence of fibrillatable PTFE whereby the resin and filler agglomerate” is suggested in column 5 of Yamada et al. (See the Advisory Action dated April 30, 2003; also see the “Summary of Arguments Regarding Yamada et al.” that is attached to the instant reply.)

However, Yamada et al. do not disclose or suggest the production method including the aggregation step described in the present specification.

Accordingly, the production method utilized in the present specification is different from the production method disclosed in Yamada et al.

The aggregation step effects the differences in the method utilized in the present specification and the method utilized in the declaration would have on the Y/X index of the produced resin composite.

Rejoinder Request

Upon allowance of claims 1-2, the Examiner is respectfully requested to rejoin method claims 3-4, which ultimately depend from claim 1.

Provisional Request for Interview

Should the present reply not result in an allowance of at least pending claims 1-2 in the application, the Examiner is respectfully requested to contact Mr. John W. Bailey (Reg. No. 32,881) at the offices of Birch, Stewart, Kolasch & Birch, LLP, at the telephone number indicated below, or at Mr. Bailey's direct work telephone number (703-205-8031) so that a personal interview can be scheduled with the Examiner at her earliest convenience in order to try to resolve issues outstanding relating to the patentability of the claimed invention.

CONCLUSION

Based upon the remarks submitted herewith, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims 1-4 are now in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Reply Under 37 CFR § 1.111

Attorney Docket No. 2185-0480P

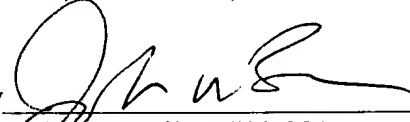
Appl. No. 09/708,519

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: December 27, 2005

Respectfully submitted,

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2185-0480P

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Attachment: "Summary of Arguments Regarding Yamada et al." (5 pages)